REMARKS

Applicant has carefully reviewed the Final Office Action mailed January 16, 2008 and offers the following remarks.

Applicant wishes to thank the Examiner for indicating that claims 4-11, 17, 22-29, and 35 would be allowable if rewritten in independent form. Applicant reserves the right to rewrite claims 4-11, 17, 22-29, and 35 at a later time.

Claims 1, 2, 4, 11, 12, and 17 were objected to for containing "adapted to" language. The Examiner has objected to the term "adapted to" as not being a positive limitation. However, the Examiner has not addressed Applicant's arguments in the previous response filed October 30, 2007, in which Applicant argued that in the present case, the term "adapted to" is a positive limitation. Since the Patent Office has not addressed Applicant's arguments, Applicant reiterates and incorporates by reference its previous arguments (Response filed October 30, 2007, pp. 2-3). Applicant also notes that the "adapted to" language by itself cannot be objectionable. A search of the U.S. Patent Office database indicates that over 492,000 patents have been issued with the term "adapted to" in the claims. Applicant therefore respectfully maintains that the "adapted to" language is proper, and requests that the rejection be withdrawn, and claims 1-36 be allowed.

Claims 1, 18, 19, and 36 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,999,770 B2 to Hirsbrunner et al. (hereinafter "Hirsbrunner"). Applicant respectfully traverses.

In the Response filed October 30, 2006, Applicant filed declarations under 37 C.F.R. § 1.131 of the inventor and the attorney drafting the patent application to show that Applicant conceived of the present invention prior to Hirsbrunner and that diligent action was taken from a time prior to the filing of Hirsbrunner through the filing of the present application to constructively reduce the present invention to practice. The Patent Office now takes the position that a declaration under 37 C.F.R. § 1.131 is inappropriate in the present case because the Hirsbrunner reference is claiming the same invention as the present invention and that the reference may be overcome only through an interference proceeding (Office Action mailed January 16, 2008, p. 2). Applicant respectfully disagrees.

M.P.E.P. § 715 states that a declaration can be used under 37 C.F.R. § 1.131 to "antedate a reference that qualifies as prior art under 35 U.S.C. § 102(e) where the reference has a prior art date under 35 U.S.C. § 102(e) prior to applicant's effective filing date, and shows but does not

claim the same patentable invention." A declaration is inappropriate only if the reference claims the same invention that the present invention claims; i.e., the **claims** of the reference anticipate or render obvious the claimed invention. M.P.E.P. §715.05.

In the present case, the claims of Hirsbrunner do not anticipate or render obvious the claimed invention. In fact, the Patent Office has already admitted this for claims 2, 3, 12-16, 20-24, and 30-34 since the Patent Office relies on Goodman as a secondary reference. Thus, it is clear that at least for claims 2, 3, 12-16, 20-24, and 30-34, Hirsbrunner does not claim the same invention as the present application. Accordingly, the declarations under 37 C.F.R. § 1.131 should be considered at least with respect to claims 2, 3, 12-16, 20-24, and 30-34. Because the Patent Office did not consider the declarations under 37 C.F.R. § 1.131 as should have been done with respect to claims 2, 3, 12-16, 20-24, and 30-34, the finality of the Office Action mailed January 16, 2008 is improper, and the finality must be withdrawn.

Even with respect to claims 1, 18, 19, and 36, these claims are not anticipated or rendered obvious by the claims of Hirsbrunner. Certainly, the Patent Office has not provided any evidence that the claims of Hirsbrunner anticipate or render obvious claims 1, 18, 19, and 36. The Patent Office has not specifically cited where each of the limitations of the claimed invention are found in the claims of Hirsbrunner. In fact, the claims of Hirsbrunner do not anticipate or render obvious the claims of the present invention. For example, claim 1 of the present invention recites a terminal comprising:

a) at least one communication interface providing network connectivity to at least one communication network; and

b) a control system associated with the at least one communication interface and adapted to:

i) determine a terminating address for a terminating party based on current network connectivity to the at least one communication network; and

ii) initiate communications with the terminating party using the terminating address.

Claim 19 has similar limitations as those found in claim 1.

In contrast, claim 1 of Hirsbrunner recites a wireless communication unit comprising:

a transceiver suitable to support an air interface with a first wireless communication network and with a second wireless communication network;

a user interface operable to initiate a call to a number of a target unit;

and a controller, coupled to the transceiver and the user interface, and operable, responsive to the call initiation and when the wireless communication unit is operating in the second wireless communication network, to selectively hairpin the call through the first communication network, wherein the controller, to selectively hairpin, is: further operable to determine when the call is likely to be handed into the first communication network; and further operable, if the call is likely to be handed into the first communication network, to hairpin the call through the first communication network.

Noticeably absent from claim 1 of Hirsbrunner are the limitations of **determining a terminating address for a terminating party based on current network connectivity to the at least one communication network** and initiating communications with the terminating party using the terminating address, which are found in claim 1 of the present invention. Thus, the claims of Hirsbrunner do not anticipate or render obvious the present claimed invention. Since the claims of Hirsbrunner do not anticipate or render obvious the present claimed invention, Hirsbrunner does not claim the same invention as the present application. Since Hirsbrunner does not claim the same invention as the present application, a declaration under 37 C.F.R. § 1.131 is appropriate and may be used. Because the Patent Office did not consider the declarations under 37 C.F.R. § 1.131 as they should have, the finality of the Office Action mailed January 16, 2008 is improper, and the finality must be withdrawn.

Based on the declarations and the facts and arguments previously set forth in Applicant's response filed October 30, 2007, Applicant respectfully submits that the date of invention for the present application was prior to the filing date of Hirsbrunner and that diligent action was taken from a time period prior to the filing date of Hirsbrunner, through the filing of the present application, to constructively reduce the invention to practice. Therefore, Hirsbrunner was not filed before Applicant's present invention. Thus, Hirsbrunner does not qualify as prior art under 35 U.S.C. § 102(e). As such, the rejection of claims 1, 18, 19, and 36 as being anticipated by Hirsbrunner is improper and should be withdrawn.

Claims 2, 3, 12-16, 20-24, and 30-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirsbrunner in view of U.S. Patent No. 7,099,306 B2 to Goodman et al. (hereinafter "Goodman"). Applicant respectfully traverses.

Since Hirsbrunner is not available as prior art, as discussed above and in Applicant's response filed October 30, 2007, the rejection of claims 2, 3, 12-16, 20-24, and 30-34 over Hirsbrunner and Goodman is also improper and must be withdrawn.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: John R. Witcher, III

John R. Witcher, III
Registration No. 39,877
100 Regency Forest Drive, Suite 160
Cary, NC 27518
Telephone: (919) 238-2300

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